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In the Supreme Court of the United States

OCTOBER TERM, 1963

No. 579

IN THE MATTER OF THE APPLICATION OF FRIEDRICH GRUSCHWITZ AND ALBERT FRITZ, PETITIONERS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The opinions of the judges of the United States Court of Customs and Patent Appeals (Pet. 1a-26a) are reported at 320 F. 2d 401.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 26, 1963 (Pet. 1a). The petition for a writ of certiorari was filed on October 24, 1963. The petitioners invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review on certiorari a decision by the United States Court of Customs and Patent Appeals in a case on appeal

from the Board of Appeals of the United States Patent Office.

2. Whether, in light of the statutory requirement that an appellant from the Patent Office to the Court of Customs and Patent Appeals set forth specifically his reasons for appeal, the Court of Customs and Patent Appeals was warranted in dismissing petitioners' appeal where their purported reasons for appeal stated no more than that the Patent Office erred in rejecting their application for a patent.

STATUTES INVOLVED

28 U.S.C. 1256 provides:

> *Court of Customs and Patent Appeals; certiorari.*—Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

35 U.S.C. 142 provides:

> When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

35 U.S.C. 144 provides with respect to decisions of the Court of Customs and Patent Appeals:

> * * * the decision shall be confined to the points set forth in the reasons of appeal.

STATEMENT

Petitioners, on February 26, 1958, applied to the Patent Office for a patent on a "Spray—Plastering—Device for Applying Mortar to Ceilings and Walls of Buildings," their asserted invention being contained in claims 10–16 of the application (Pet. 1a–2a). Both the examiner and the Board of Appeals of the Patent Office rejected their claims as unpatentable over a prior German patent issued to the petitioners (Pet. 1a). Specifically, the rejection over this reference was based on the provision in 35 U.S.C. 102(d), that an invention is not patentable if

> the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States.

The disputed question raised in the Patent Office proceedings involved the date when the invention was patented in Germany (Pet. 2a). If it was patented prior to February 26, 1958, as the Patent Office ruled, the present application was barred by section 102(d); but if the invention was patented after that date, as the petitioners contended, their application was not barred (Pet. 2a–3a).

In their notice of appeal from the Patent Office's Board of Appeals to the Court of Customs and Patent Appeals, the petitioners set forth as reasons for appeal the following (Pet. 3a):

1. It was error to affirm the decision of the Examiner in his rejection of claims 10 to 16.

2. It was error to refuse to allow the rejected claims.

A majority of the Court of Customs and Patent Appeals, in an opinion by Chief Judge Worley joined by Judge Jackson (Pet. 1a–7a), and a separate opinion by Judge Martin (Pet. 7a–8a), held that the reasons for appeal contained in the petitioners' notice were inadequate, and dismissed the appeal for want of jurisdiction. Judges Rich (Pet. 8a–26a) and Smith (Pet. 26a) dissented.

ARGUMENT

Recently this Court declined to rule on the question whether decisions of the Court of Customs and Patent Appeals, in patent cases on appeal from the Patent Office, are reviewable on certiorari. *Glidden Company* v. *Zdanok*, 370 U.S. 530, 578, n. 49. In our view there is no need for the Court to rule on that question in the instant case because the decision below is correct on the merits. There is a statutory requirement that an appellant in a patent case seeking review in the Court of Customs and Patent Appeals state in writing his reasons for appeal. The petitioners' purported statement, setting forth no more than that the Patent Office had erred, was in reality no statement of reasons for appeal. In addition, the question of the procedures to be followed in taking patent appeals to the Court of Customs and Patent Appeals is now before Congress in the form of a proposal to amend Title 35 of the United States

Code. Any issues arising from the Court of Customs and Patent Appeals' application of the procedural statutes here involved may well be obviated by Congressional action.

1. In *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, this Court held that a decision of the Court of Appeals of the District of Columbia, on appeal from a decision of the Patent Office relating to a patent and trademark application, was not a judicial determination but "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. at 698–699. Since such a decision did not, in the Court's view, present a justiciable case or controversy, it was deemed beyond the constitutional powers conferred upon this Court.

The jurisdiction of the Court of Appeals for the District of Columbia Circuit over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1–4, 45 Stat. 1475. But the nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction," citing *Postum Cereal*. In subsequent patent cases, the Court has merely denied certiorari, without more.

However, the basis for the decision in *Postum Cereal* was overruled in *Glidden Company* v. *Zdanok*, 370 U.S. 530. In light of the opinion in *Glidden*,

there is now no constitutional obstacle to review by this Court of patent rulings of the court below. The subsisting question is whether Congress intended to vest such jurisdiction in this Court.

Prior to 1948, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was one relating to customs cases. That provision—Section 195 of the old Judicial Code (36 Stat. 1145), as amended[1]—had two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. In 1948, with the codification of Title 28 of the United States Code, the two elements of section 195 of the old Judicial Code were separated, with the former being placed in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[2] However, upon codification in 1948, the language of the provision dealing with this Court's certiorari jurisdiction was changed. Instead of providing only for certiorari in "customs" cases from the Court of Customs and Patent Appeals, 28 U.S.C. 1256 provides for review by this Court of "[c]ases in the Court of Customs and Patent Appeals." The terms of the statute are now sufficiently broad to cover all cases. But apart from

[1] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

[2] The Revisers Notes to Sections 1256 and 1541 confirm the derivation of those provisions.

this change in wording, there are no indications, one way or the other, of Congressional purpose.

Militating against a construction of 28 U.S.C. 1256 as encompassing patent and trademark cases is the fact that there is nothing else in the codifying act or its legislative history suggesting that Congress had any design to provide for review of a class of cases over which jurisdiction had previously been withheld.[3] On the other hand, the wording of the statute is no longer limited. We do not urge that the question is one which would not warrant examination in an appropriate case. However, the instant case would not seem to be one which demands resolution of this jurisdictional issue.

2. Section 142 of 35 U.S.C. requires that, in addition to filing a notice of appeal, the appellant, in taking an appeal from the Patent Office to the Court of Customs and Patent Appeals, shall file with the Patent Office in writing his reasons for appeal. Section 144 of 35 U.S.C. provides that the decision of the court *must* be confined to the points set forth in the reasons for appeal. The Court of Customs and Patent Appeals has consistently held that, under these provisions, the requirements of adequate reasons for appeal is jurisdictional. *In re Dickler*, 110 F.2d 664.

In the present case, the Patent Office had held that the petitioners' invention had been patented in Germany prior to the application for a patent filed in the United States, and that the German application

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[3] See Stern and Gressman, *Supreme Court Practice* (3d ed., 1962), Sec. 2-22.

had been filed more than a year before the application in this country (R. 21–22, 32–44).* Since both of these factors were present, the American application was barred by 35 U.S.C. 102(d). The contested issue before the Patent Office was whether the German invention was patented on January 23, 1958, when a notice in the Patentblatt (Patent Gazette) announced that a patent had been granted, or whether it was patented in Germany on April 11, 1958, when the specification of the patent was issued in printed form in Germany (a date subsequent to the application in this country) (Pet. 2a–3a; R. 33–34). Underlying this issue were considerations of German patent law and practice, which the Patent Office's Board of Appeals discussed in detail (R. 34–42).

In light of the issue before the Patent Office, it would seem that the petitioners' statement of reasons for appeal should have alleged that the Patent Office erred in ruling that their invention was patented in Germany on January 23, 1958, instead of on April 11, 1958, and that, therefore, their application in this country was not barred by 35 U.S.C. 102(d). However, there was nothing contained in their reasons for appeal even remotely suggesting that this was their complaint.

These so-called reasons for appeal, stating no more than that the Patent Office erred, added nothing to the notice of appeal itself. To uphold such a statement would be to ignore the statutory requirement of spe-

* "R." refers to the Transcript of Record before the United States Court of Customs and Patent Appeals, which is part of the record in this Court.

cific assignments of error. As Chief Judge Worely pointed out below (Pet. 7a), "To hold that the instant reasons of appeal are adequate would necessarily require us to ignore what Congress has expressly directed, or to stretch the statute to a point we are confident Congress did not intend."

There is another factor militating against certiorari in this case. The jurisdictional requirement of reasons for appeal in patent appeals to the Court of Customs and Patent Appeals is currently being reexamined by Congress in connection with a bill pending before the House Committee on the Judiciary. See H.R. 7553, 88th Congress, 1st session, introduced July 15, 1963. This bill would amend sections 142, 143, and 144 of 35 U.S.C. for the purpose of conforming the procedures in patent appeals to those governing appeals from the district courts to the courts of appeal. Under the proposed bill, the appellant would only be required to file a statement of points if he designates as the record on appeal less than the complete patent office record. Furthermore, the proposed amendment provides that the failure to file a statement of points even where less than the entire record is designated "does not affect the validity of the appeal or the jurisdiction of the court to hear and decide the appeal or any point therein" and that this failure "is ground for only such action as the court deems appropriate, which may include dismissal of the appeal in whole or in part." Thus, the failure to file a statement of reasons for appeal would not be jurisdictional. Both the Department of Commerce

and the Department of Justice, before the House Judiciary Committee, have indorsed this provision of H.R. 7553.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ARCHIBALD COX,
Solicitor General.
JOHN W. DOUGLAS,
Assistant Attorney General.
MORTON HOLLANDER,
JOHN C. ELDRIDGE,
Attorneys.

DECEMBER 1963.

U.S. GOVERNMENT PRINTING OFFICE, 1963